

PATENT

REMARKS

The Office Action dated April 21, 2005 has been received and carefully considered. Reconsideration of the outstanding rejections is respectfully requested in view of the following remarks.

Rejections of Claims 1-46 / Disqualification of Endo as a Reference under Section 102(e)

At page 5 of the Office Action, claims 1-4, 6, 28 and 41-43 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Endo (U.S. Patent No. 6,615,303). At page 5 of the Office Action, claims 5, 7-27, 29-40 and 44-46 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Endo in view of Official Notice. These rejections are respectfully traversed.

The Examiner asserts that Endo discloses each and every feature of claims 1-4, 6, 28 and 41-43, and further that Endo, in combination with the Examiner's "Official Notice," discloses all of the features recited in claims 5, 7-27, 29-40 and 44-46. The Applicant respectfully traverseSthe Examiner's assertions and respectfully submitSthat, as discussed in the Response mailed February 23, 2005, Endo fails to disclose or suggest, alone or in combination with the Examiner's "Official Notice," each and every feature recited in claims 1, 7, 18, and 26, from which claims 5, 8-17, 19-25, 27, 29-40 and 44-46 depend, respectively. Moreover, not only does Endo fail to disclose or suggest all of the claimed features, the Applicant has filed herewith a Declaration under 37 C.F.R. Section 1.131 (attached as Appendix A) which establishes that the conception of the subject matter of the present application antedates the filing date of Endo, thereby disqualifying Endo as a valid reference under 35 U.S.C. § 102(e). See 37 C.F.R. § 1.131 ("When an appropriate oath or declaration is made, the patent or publication cited [under 35 U.S.C. § 102(a) or (e)] shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent").

As provided on the face of the patent, the *applicable* filing date of Endo under 35 U.S.C. Section 102(e) is May 19, 2000 (hereinafter, "the effective date"). See *M.P.E.P.* § 706.02(f)(1)(I)(D). As evinced by paragraph 3 of the Declaration, all activities leading to the conception of the claimed subject matter occurred in Canada (both a NAFTA country and a

PATENT

WTO member country). As evinced by paragraph 4 of the Declaration, an invention disclosure form disclosing the claimed subject matter was provided to a representative of the Assignee of the present application prior to the effective date of Endo. As evinced by paragraphs 4-7, due diligence was performed in the reduction of the invention to practice until the filing of the application on September 28, 2000.

In view of the foregoing, it is respectfully submitted that the Declaration is appropriate under 37 C.F.R. Section 1.131 as it establishes that (a) the subject matter of the invention was conceived prior to the effective date of Endo (*see Declaration*, para. 4); (b) due diligence was exercised in constructively reducing the invention to practice from before the effective date of Endo to the filing of the present application (*see Declaration*, paras. 4-7); and (c) the activities resulting in the conception of the subject matter of the present application occurred in a NAFTA country and a WTO member country (*see Declaration*, para. 3). Accordingly, Endo "shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent." 37 C.F.R. § 1.131(b).

Because Endo is disqualified as a Section 102(e) prior art reference, the Applicant respectfully submits that rejections of claims 1-46 based on Endo are improper at this time and withdrawal of these rejections is respectfully requested.

Conclusion

The Applicant respectfully submits that the present application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-0441.

PATENT

Respectfully submitted,

21 June 2005
Date



Ryan S. Davidson, Reg. No. 51,596,
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone) (512) 327-5452 (fax)